

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

Remarks/Arguments

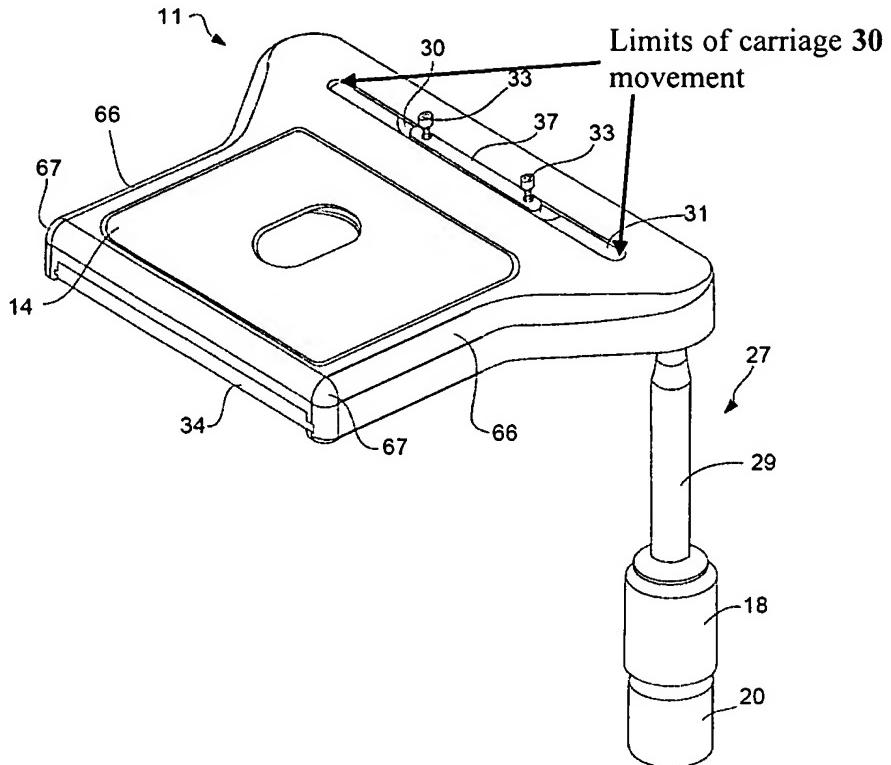
The Rejection of Claims 1, 3, 8-16, 18, 20-21, 24-25 and 35-36 Under 35 U.S.C. § 112

The Examiner has rejected Claims 1, 3, 8-16, 18, 20-21, 24-25 and 35-36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner asserted that the claims contain subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection and request reconsideration for the following reasons.

Applicants courteously submit that the specification and drawings support the limitation of "...said drive means for said carriage and stage are shielded by said bottom side of said stage throughout the full range of motion of said carriage and stage..." as the drawings clearly show such an arrangement. Figure 3 shows that elevation 37 of carriage 30 is disposed within slot 31 and is "of suitable dimension for entry and unimpeded slidable movement within slot 31." (See Para. [0025]). As can be seen in Figure 3 below, elevation 37 will limit the movement of carriage 30 as further movement of carriage 30 in a given direction is physically impossible as elevation 37 contacts either end of slot 31.



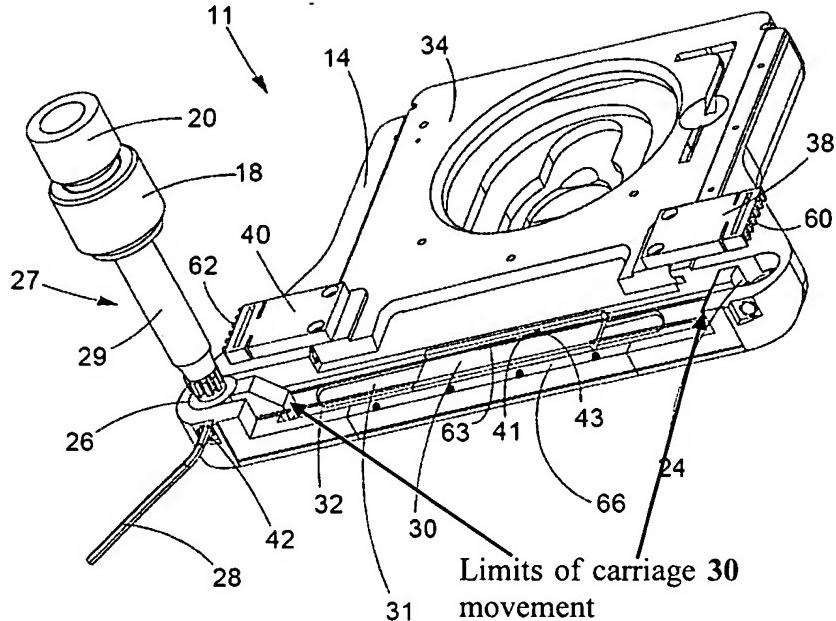
Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007



Applicants' Fig. 3

Furthermore, Figure 8 below shows that carriage 30 is disposed within a slot located on the bottom side of stage 14. Again, the movement of carriage 30 is limited by the physical constraints of the slot as carriage 30 cannot move outside of the slot.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007



Applicants' Fig. 8

Thus, Applicants courteously submit that the full range of motion of carriage 30 is described within the specification and figures.

Additionally, Applicants respectfully assert that regardless of the extent of movement of the stage, the drive mechanism is always shielded by the stage, as the drive mechanism includes only drive mechanism 27, and drive 27 is mounted on the bottom side of the stage, *i.e.*, shielded by the stage. As recited in Paragraph [0023], the microscope stage assembly includes drive mechanism 27, while in Paragraph [0026], drive 27 is further described as including drive shaft 29, pinion 58 and first and second stage positioning knobs 18 and 20, respectively. Drive shaft 29 further comprises outer and inner drive shafts 22 and 48, respectively. Applicants courteously submit that racks 38 and 40 are not part of drive mechanism 27 as described in the instant application, and thus, the apparent depiction of racks 38 and 40 in Figures 6-8 is not relevant to this discussion as racks 38 and 40 are not part of drive mechanism 27.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

Hence, as drive mechanism 27 is mounted to and covered by the bottom side of stage 14 (See Figures 9 and 10), it generally follows that drive mechanism 27 is shielded by stage 14. Additionally, as drive mechanism 27 is attached to stage 14, any movement of stage 14 relative to mounting plate 34 also results in movement of drive mechanism 27 relative to mounting plate 34, but not movement relative to stage 14. In other words, as stage 14 moves, drive mechanism 27 also moves, however, stage 14 and drive mechanism 27 do not move relative to each other. Thus, drive mechanism 27 is always shielded by stage 14, regardless of the position of stage 14.

In view of the foregoing, Applicants courteously submit that the limitation "...said drive means for said carriage and stage are shielded by said bottom side of said stage throughout the full range of motion of said carriage and stage..." is supported by the specification and drawings of the instant application, and therefore Claims 1 and 36 satisfy the requirements of 35 U.S.C. § 112, first paragraph. In like fashion, as Claims 3, 8-16, 18, 20-21, 24-25 and 35 contain all the limitations of the claims from which they depend, *i.e.*, Claim 1, it follows that Claims 3, 8-16, 18, 20-21, 24-25 and 35 also satisfy the requirements of 35 U.S.C. § 112, first paragraph.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 1, 3, 8-16, 18, 20-21, 24-25 and 35-36, as amended, are in condition for allowance, which action is courteously requested.

The Rejection of Claim 36 Under 35 U.S.C. § 112

The Examiner has rejected Claim 36 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. More specifically, the Examiner asserted that the claim contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. Applicants respectfully traverse this rejection and request reconsideration for the reasons stated above and the following reasons.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

Applicants have amended Claim 36 to remove "...completely..." thereby rendering this rejection moot. Hence, Applicants courteously submit that amended Claim 36 satisfies the requirements of 35 U.S.C. § 112, first paragraph. Therefore, in view of the foregoing, Applicants respectfully assert that Claim 36, as amended, is in condition for allowance, which action is courteously requested.

The Rejection of Claims 1, 3, 8, 18, 20-21 and 35 Under 35 U.S.C. § 102

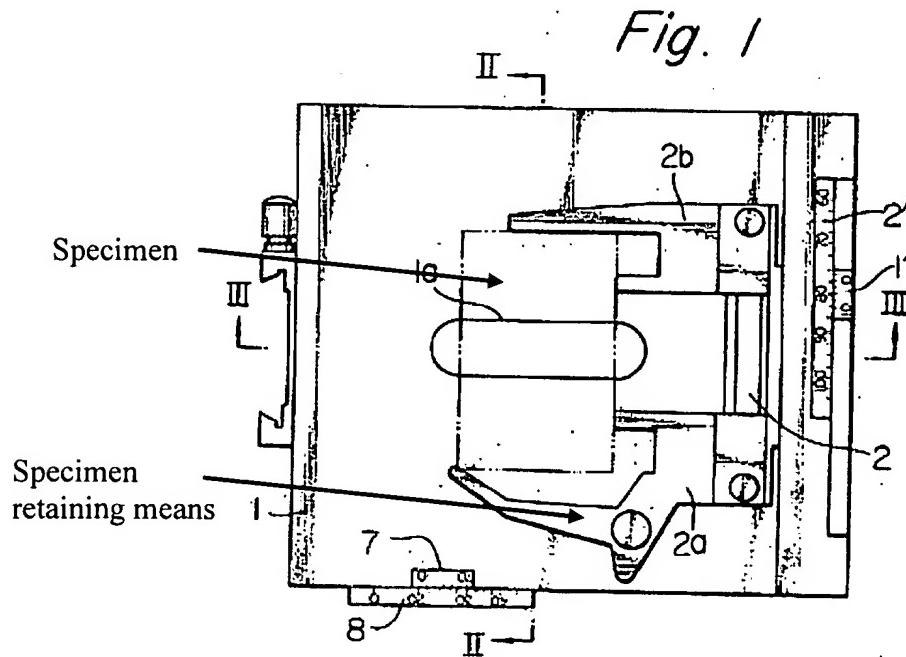
The Examiner has rejected Claims 1, 3, 8, 18, 20-21 and 35 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 3,572,888 (*Kawashima*). Applicants respectfully traverse this rejection and request reconsideration based on the following reasons.

"A claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described in a single prior art reference." *Vandergaal Bros. v. Union Oil of California*, 814 F.2d 628, 631; 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Moreover, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). In other words, the elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, *i.e.*, identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

Applicants courteously submit that Claim 1 recites an arrangement that is not taught in *Kawashima*. More specifically, *Kawashima* does not teach a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for the carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage wherein the specimen retaining means is removably attached to the carriage through the opening in the stage, as taught in Applicants' Claim 1. Applicants respectfully assert that *Kawashima* teaches "upper stage 1 slidably supports thereon a clamping holder 2 having a pair of clamping arms 2a and 2b in the conventional manner...the clamping holder 2 is supported by a slide member 3 slidably guided in the upper stage member 1 by means of bearing balls 4 so that the slide member 3 is moved in the direction perpendicular to

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

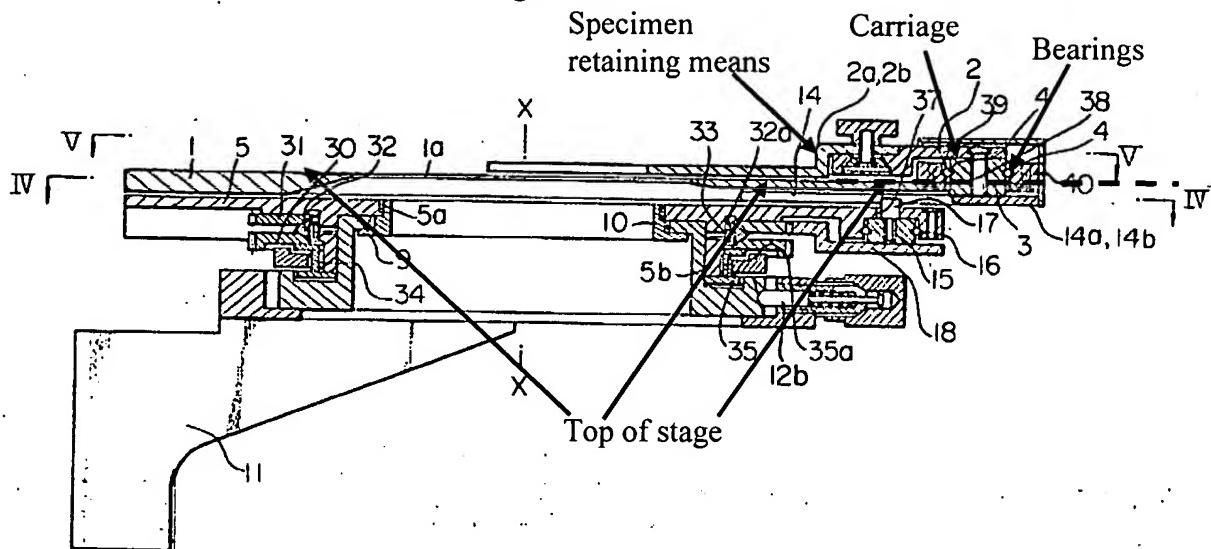
the plane of FIG. 3, i.e., in the vertical direction in FIG. 1 together with the clamping holder 2.” (*Kawashima*, Col. 3, Lines 16-23). In other words, *Kawashima* teaches a microscope stage assembly having a top side and a bottom side; a carriage and bearings for the carriage; and, a specimen retaining means attached to the carriage, however, the carriage attached to the specimen retaining means and the bearings for the carriage are disposed above the stage and therefore cannot be shielded by the bottom side of the stage. (See the following Figures).



Kawashima Fig. 1

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

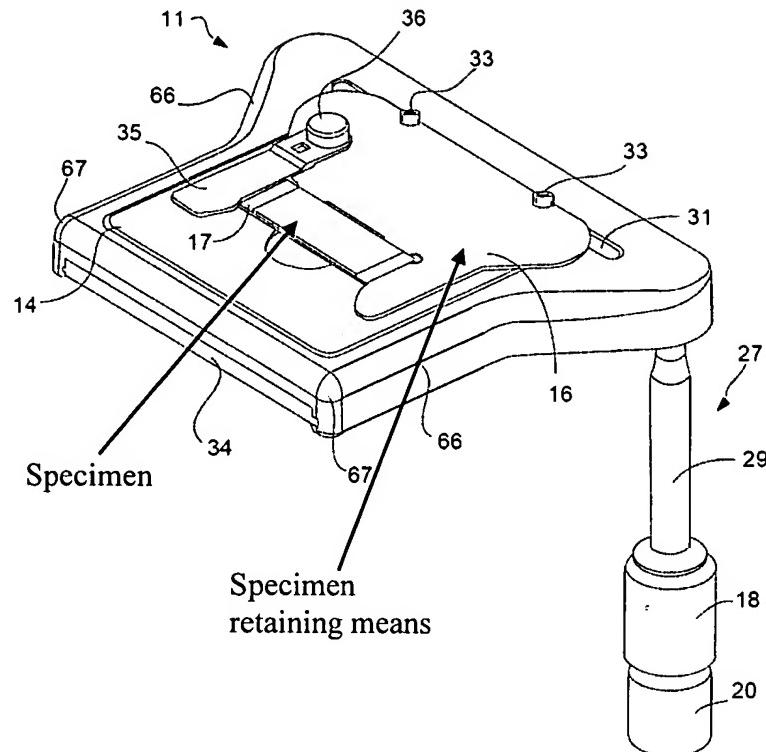
Fig. 3



Kawashima Fig. 3

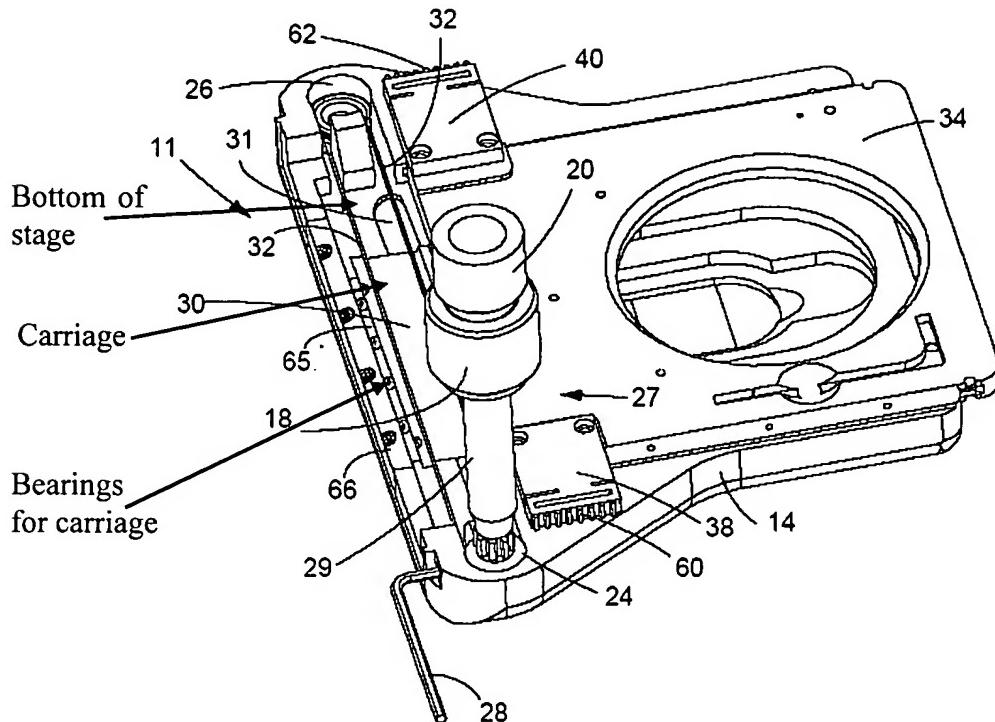
Contrarily, Applicants teach a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for said carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage wherein the specimen retaining means is removably attached to the carriage through the opening in the stage. (See the following Figures)

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

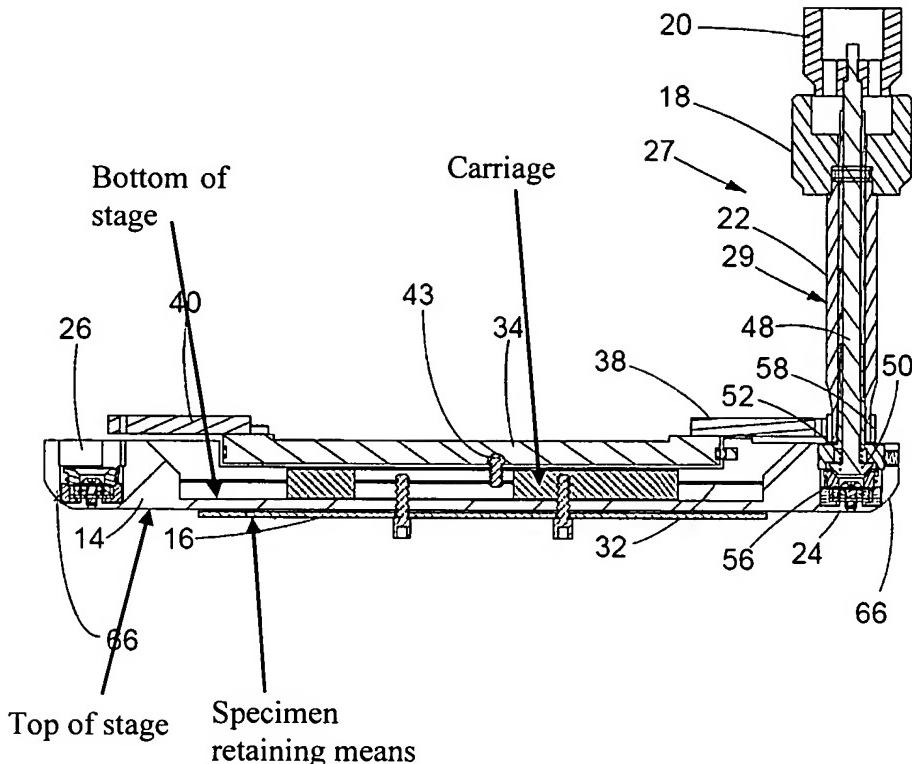


Applicants' Fig. 2

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007



Applicants' Fig. 6



Applicants' Fig. 10

Hence, as Applicants' Claim 1 contains an arrangement of elements not taught in *Kawashima*, it generally follows that *Kawashima* does not anticipate Applicants' Claim 1. In like fashion, as Claims 3, 8, 18, 20-21 and 35 contain all the limitations of the claims from which they depend, *i.e.*, Claim 1, it follows that Claims 3, 8, 18, 20-21 and 35 are also not anticipated by *Kawashima*.

Furthermore, as *Kawashima* does not teach, suggest or motivate one to include the arrangement of elements as recited in Applicants' Claim 1, it follows that Claim 1 is nonobvious in view of *Kawashima*. Again, due to their dependency from Claim 1, Claims 3, 8, 18, 20-21 and 35 are also nonobvious in view of *Kawashima*.

Therefore, in view of the foregoing, Applicants respectfully assert that Claims 1, 3, 8, 18, 20-21 and 35 are in condition for allowance, which action is courteously requested.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

The Rejection of Claims 9-10, 13, 15 and 24 Under 35 U.S.C. § 102

The Examiner has rejected Claims 9-10, 13, 15 and 24 under 35 U.S.C. § 102(b) as being anticipated by *Kawashima*. Applicants respectfully traverse this rejection and request reconsideration based on the reasons set forth above and the following reasons.

As described above, Claim 1 contains an arrangement of elements not taught in *Kawashima*, it generally follows that *Kawashima* does not anticipate Applicants' Claim 1. In like fashion, as Claims 9-10, 13, 15 and 24 contain all the limitations of the Claims from which they depend, *i.e.*, Claim 1, it follows that Claims 9-10, 13, 15 and 24 are also not anticipated by *Kawashima*.

Therefore, Applicants respectfully assert that Claims 9-10, 13, 15 and 24 are in condition for allowance, which action is courteously requested.

The Rejection of Claims 11-12, 14, 16 and 25 Under 35 U.S.C. § 102

The Examiner has rejected Claims 11-12, 14, 16 and 25 under 35 U.S.C. § 102(b) as being anticipated by *Kawashima*. Applicants respectfully traverse this rejection and request reconsideration based on the reasons set forth above and the following reasons.

As described above, Claim 1 contains an arrangement of elements not taught in *Kawashima*, it generally follows that *Kawashima* does not anticipate Applicants' Claim 1. In like fashion, as Claims 11-12, 14, 16 and 25 contain all the limitations of the Claims from which they depend, *i.e.*, Claim 1, it follows that Claims 11-12, 14, 16 and 25 are also not anticipated by *Kawashima*.

Therefore, Applicants respectfully assert that Claims 11-12, 14, 16 and 25 are in condition for allowance, which action is courteously requested.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

The Rejection of Claim 36 Under 35 U.S.C. § 103

The Examiner rejected Claim 36 under 35 U.S.C. § 103(a) as being unpatentable over *Kawashima* in view of U.S. Patent No. 5,172,265 (*Noguchi et al.*). Applicants respectfully traverse this rejection and request reconsideration for the reasons set forth above and the following reasons.

As described *supra*, Applicants courteously submit that the device taught by *Kawashima* does not include a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for said carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage wherein the specimen retaining means is removably attached to the carriage through the opening in the stage, as recited in Applicants' amended Claim 36.

Hence, as Applicants' amended Claim 36 contains an arrangement of elements not taught in *Kawashima*, it generally follows that *Kawashima* does not anticipate Applicants' amended Claim 36. Furthermore, as *Kawashima* does not teach, suggest or motivate one to include the arrangement of elements as recited in Applicants' amended Claim 36, it follows that amended Claim 36 is nonobvious in view of *Kawashima*.

Similarly, *Noguchi et al.* fail to teach a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for said carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage wherein the specimen retaining means is removably attached to the carriage through the opening in the stage, as recited in Applicants' amended Claim 36. More specifically, *Noguchi et al.* disclose a microscope having a hand-support, however are silent regarding the structure and/or placement of a carriage, bearings for the carriage and specimen retaining means. As such, *Noguchi et al.* fail to cure the defects of *Kawashima*, i.e., they do not teach a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for said carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

wherein the specimen retaining means is removably attached to the carriage through the opening in the stage, as recited in Applicants' amended Claim 36.

In order to establish a *prima facie* case of obviousness, the references alone or in combination must teach or suggest all the limitations of Applicant's claimed invention. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991). Thus, as amended Claim 36 contains at least one element that is not disclosed in the cited references, *i.e.*, a microscope stage assembly comprising a stage having a top side, a bottom side and an opening in the form of a linear slot; a carriage and bearings for said carriage shielded by the bottom side of the stage; and, a specimen retaining means on the top side of the stage wherein the specimen retaining means is removably attached to the carriage through the opening in the stage, it generally follows that amended Claim 36 is patentable over *Kawashima* in view of *Noguchi et al.*.

Accordingly, withdrawal of the rejection of Claim 36 under 35 U.S.C. § 103(a) is appropriate and respectfully requested.

Attorney Docket No.: LEAP:133US
U.S. Patent Application No. 10/810,979
Reply to Office Action of November 21, 2006
Amendment Dated: February 21, 2007

Conclusion

Applicants respectfully submit that the present application is in condition for allowance, which action is courteously requested. The Examiner is invited and encouraged to contact the undersigned agent of record if such contact will facilitate an efficient examination and allowance of the application.

Respectfully submitted,



Robert C. Atkinson
Agent for Applicants
Registration No. 57,584
Simpson & Simpson, PLLC
5555 Main Street
Williamsville, NY 14221-5406
Telephone No. 716-626-1564

RCA/

Dated: February 21, 2007